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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,226	11/12/2003	John W. Rohrer		6313

7590 12/22/2004
John W. Rohrer
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EXAMINER

LEGESSE, NINI F

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,226	Applicant(s) ROHRER, JOHN W.	
	Examiner Nini F. Legesse	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 9,16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response to the last office action is acknowledged on 10/07/04. It is noted that claims 14-18 were missing from the initial office action. A new non-final office action is provided below.

Claim Objections

Claims 16 and 17 are objected to because of the following informalities: Applicant changed claim 17 to claim 16. However, it is noted that claim 16 already exist on page 7. Therefore, claim 16 on page 18 needs to be claim 17 and claim 17 on page 8 needs to be claim 18. Appropriate correction is required.

Claim 9 is objected. What is the expression "aft" at the end of the claim?

For purpose of examining the claims, claim 16 on page 8 is changed to claim 17 and claim 17 on page 8 is changed to claim 18.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has failed to be specific in what he is claiming. A lot of alternative language is used in the claims making the claims indefinite. For example in claim 1, is the device white or is it light colored. What is the expression "light colored" including or excluding? Is the shape of the device spherical or is it curved

or is it flat? What does the base look like? Is it to be flat or does it have multiple "profections"? What is "profections"? These are just few examples among many that indicate that the claims are failing to particularly point out and distinctly claim the subject matter that applicant regards as his invention. The claims are replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The claims have not been checked to the extent necessary to determine the presence of all possible indefinite expression. Applicant is expected to amend the claims to overcome the multiple indefinite expressions though out the claims.

With respect to claims 6 and 9, the claims are indefinite because it appears that Applicant is claiming the different embodiments of his invention together. As shown on Figs. 1-3 the base element (5) is only attached to the face of the putter. However, on the second embodiment of the instant application, the base element (30) is attached to the putter with element 32 that is considered a flexible hinge on page 11 of the instant application. It is not clear how the embodiment as shown in Figs. 1-3 of the instant application is capable of being flexibly attached to the club head.

AS BEST UNDERSTOOD THE CLAIMS ARE REJECTED AS FOLLOWS:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Halsey et al. (US Patent No. 5,725,439).

With respect to claim 1, Halsey discloses a light mechanism that is attached to the front of a golf club (1).

With respect to claim 2, the focused beam is a laser beam (52).

With respect to claim 6, mounting base (24) is rigidly attached to the putter head.

With respect to claim 8, the base (24) is capable of adjustment.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 7, 8, 9, 10 and 13 rejected under 35 U.S.C. 102(e) as being anticipated by Hambly (US Patent No. 6,579,191).

With respect to claim 1, Hambly discloses a light mechanism (40) that is an attached to the front of a golf club (as shown on Fig. 1).

With respect to claim 2, the focused beam is a laser beam (40).

With respect to claims 5 and 7, mounting base (20 and 60) is set on the ground or a floor unattached to the club head and the beam is at normal angle to the clubface (referring to Fig. 1, wherein item 37 is on a horizontal position as shown as a hidden line).

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With respect to claims 8 and 9, mechanical means (52) is capable of allowing the beam of the device to maintain its height or attitude relative to the ground.

With respect to claim 10, the device has a switch (54).

With respect to claim 13, the device has elastomer bottom with small projections (see column 3, lines 17-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halsey in view of Official Notice.

Halsey discloses the use of a laser source (52). However, the use of any other type of light mechanism including infrared, radio frequency or electro-magnetic sources would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the training device with any one of them since the examiner takes Official Notice of the equivalence of the above listed sources for their use in the golf art and the selection of any of these known equivalents to provide light in a training device would be within the level of ordinary skill in the art.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hambly. The device of Hambly appears to meet the claim.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halsey in view of Ogden (US Patent No. 5,374,063).

Halsey fails to show a switch that is located on the grip section of the club. However positioning a switch on grip area is old in the golf art. Ogden is one reference among many that teaches a grip area switch location (see item 32 on Fig. 1). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to position switch (58) of the Halsey's invention at the grip area of the club in order to make the switch easily accessible to the user so that he/she would not have to bend to actuate the switch.

Response to Arguments

Applicant argues that Halsey fails to provide the visual appearance of a golf ball. However since the claims are replete with indefinite expression, as best understood, Halsey meets the claims as stated in the above rejections.

With respect to the argument regarding claim 6, Applicant appears to be claiming the different embodiments of his invention together. As shown on Figs. 1-3 the base element (5) is only attached to the face of the putter. However, on the second embodiment of the instant application, the base element (30) is attached to the putter with element 32 that is considered a flexible hinge on page 11 of the instant application.

It is not clear how the embodiment as shown in Figs. 1-3 of the instant application is capable of being flexibly attached to the club head.

In response to applicant's argument that intended use of the Hambly reference is different than the intended use of the instant application, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL

12/15/04


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